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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,927	01/04/2001	Randy L. Prakken	SWIF 1981	3848
7812	7590	01/09/2008		
SMITH-HILL AND BEDELL, P.C. 16100 NW CORNELL ROAD, SUITE 220 BEAVERTON, OR 97006			EXAMINER SHERR, CRISTINA O	
			ART UNIT 3621	PAPER NUMBER
			MAIL DATE 01/09/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/754,927

Applicant(s)

PRAKKEN ET AL.

Examiner

Cristina Owen Sherr

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to applicants' amendment filed October 19, 2007. Claims 1-26 are currently pending in this case.

Response to Arguments

2. Applicant's arguments filed October 19, 2007 have been fully considered but they are not persuasive.

3. Applicants argue, regarding independent claims 1, 12, and 23, that nothing in the cited reference teaches, discloses or suggests wherein the "license stamp" indicates a file was forwarded by a licensed server.

4. Examiner respectfully disagrees and directs attention to Stefik, wherein an attached "description tree file" for each digital work "makes it possible to examine the rights and fees for a work without reference to the content of the digital work" (col 9 ln 27-30). Further, the "description tree for a digital work is comprised of a set of related descriptor blocks (d-blocks)." (col 9 ln 52-53). Finally, "a d-block 700 includes an identifier 701 which is a unique identifier for the work in the repository, a starting address 702 providing the start address of the first byte of the work, a length 703 giving the number of bytes in the work, a rights portion 704 wherein the granted usage rights and their status data are maintained, a parent pointer 705 for pointing to a parent d-block and child pointers 706 for pointing to the child d-blocks In the currently preferred embodiment, the identifier 701 has two parts. The first part is a unique number assigned to the repository upon manufacture." (col 9 ln 55-65). The unique number assigned to

the repository upon manufacture identifies the repository and lets the recipient or destination computer know whether that repository is an authorized repository or not.

5. Applicants argue, regarding independent claims 1, 12, and 23, that nothing in the cited reference teaches, discloses or suggests wherein the "destination computer responds to the license stamp".

6. Examiner respectfully disagrees and directs attention to Stefik, wherein if "the master repository which generated the certificate is not known to the repository receiving the software, then the software cannot be installed." (col 13 ln 37-40). Note that the "unique number", above, identifies the repository from which the digital item has come. Thus, the destination computer is responding to the license stamp.

7. Applicants argue, regarding independent claims 1, 12, and 23, that nothing in the cited reference teaches, discloses or suggests wherein the "destination computer checks the license stamp after it is received by the destination computer".

8. Examiner respectfully disagrees and directs attention to Stefik, wherein if "the master repository which generated the certificate is not known to the repository receiving the software, then the software cannot be installed." (col 13 ln 37-40). Note that the "unique number", above, identifies the repository from which the digital item has come. Thus, the destination computer is responding to the license stamp which it must have checked after it was received.

9. Applicants argue, regarding independent claims 1, 12, and 23, that nothing in the cited reference teaches, discloses or suggests wherein the "lack of a

proper license stamp prevents software on the receiver computer from carrying out an action relative to the data file".

10. Examiner respectfully disagrees and directs attention to Stefik, wherein if "the master repository which generated the certificate is not known to the repository receiving the software, then the software cannot be installed." (col 13 ln 37-40). Note that the "unique number", above, identifies the repository from which the digital item has come. Thus, the destination computer is responding to the license stamp, by preventing software on the computer from carrying out an action, such as installation relative to the data file.

11. Applicants argue, regarding dependent claims 2, 13, and 26, that nothing in the cited reference teaches, discloses or suggests wherein "the embedded license stamp identifies the source computer".

12. Examiner respectfully disagrees and directs attention to Stefik, wherein an attached "description tree file" for each digital work "makes it possible to examine the rights and fees for a work without reference to the content of the digital work" (col 9 ln 27-30). Further, the "description tree for a digital work is comprised of a set of related descriptor blocks (d-blocks)." (col 9 ln 52-53). Finally, "a d-block 700 includes an identifier 701 which is a unique identifier for the work in the repository, a starting address 702 providing the start address of the first byte of the work, a length 703 giving the number of bytes in the work, a rights portion 704 wherein the granted usage rights and their status data are maintained, a parent pointer 705 for pointing to a parent d-block and child pointers 706 for pointing to the child d-blocks In the currently preferred

embodiment, the identifier 701 has two parts. The first part is a unique number assigned to the repository upon manufacture.” (col 9 ln 55-65). The unique number assigned to the repository upon manufacture identifies the repository or “source computer” or “particular server that forwarded the data”.

13. Applicants argue, regarding claims 3-6, 14-17, 24, and 25, that nothing in the cited reference discloses, teaches or suggests “print files of the type that directly input to a printer or about embedding anything in a print file”.

14. Examiner respectfully disagrees and directs attention to Stefik, wherein col 8 ln 32-53 discusses a printer as rendering system. It is obvious that the various digital files must somehow be suitable for printing or else the printer would not be able to print or render the said files. Further, in Stefik, “To discourage unauthorized copying of the print outs, it would be possible for the printer to print tracer messages discretely on the pages identifying the printing transaction, the copy number, and any other identifying information. The tracer information could be secretly embedded in the text itself (encoded in the grey scale) or hidden in some other way.” (col 48 ln 20-25). Here rights, license, copy count, etc, are embedded in the printed file.

15. Applicants argue, regarding claims 4, 15, and 25 that nothing in the cited reference teaches, discloses or suggests, having a document printed while ignoring or omitting things embedded in the file.

16. Examiner respectfully disagrees and directs attention to Stefik, wherein, “once a digital work is printed on paper, it can be copied on ordinary photocopying machines without intervention by a repository to collect usage fees. If the printer to a

digital disk is permitted, then that digital copy is outside of the control of usage rights.”.
(col 37 ln 9-14).

17. Regarding Applicants’ arguments in claims 9, 10, 20, and 21, see responses under claims 1, 12, and 23, above.

18. Examiner respectfully disagrees and directs attention to Stefik, wherein “(s)uppose that a user logs into a home repository and wants to spool print jobs for a digital work at a remote printing repository. The user interface for this could treat this as a request to "spool" prints. Underneath this "spooling" request, however, are standard rights and requests. To support such requests, the creator of the work provides a Copy right, which can be used to copy the work to a printing repository. In the default case, this Copy right would have no fees associated for making the copy. However, the Next-Set-Of-Rights for the copy would only include the Print rights, with the usual fees for each variation of printing. This version of the Copy right could be called the "print spooling" version of the Copy right. The user's "spool request" is implemented as a Copy transaction to put a copy of the work on the printing repository, followed by Print transactions to create the prints of the work. In this way, the user is only billed for printing that is actually done. Furthermore, the rights, conditions and fees for printing the work are determined when the work is about to be printed.” (col 49 ln 62- col 50 ln 14). Here, the digital files have a code which permits the option of printing or not. Or rather of merely spooling or spooling and printing. The user is only billed if the second option (spooling *and* printing) is exercised.

19. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

20. Claims 1-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stefik et al (US 5,629,980).

21. Regarding claim 1 –

Stefik discloses a data file distribution and processing system (e.g. ab, col 3 ln 50-52) including server software running on a source computer for sending data files to a destination computer via a network link between the source computer and the destination computer, and including processing software running on the destination computer for processing each data file forwarded thereto from said server software to carry out an action, a method for preventing the processing software running on the destination computer from processing data files forwarded to the destination computer other than from the server software, the method comprising the steps of: including within the server software running on the source computer license stamping means for embedding a license stamp into each data file before the server software forwards the data file to said destination computer via said network link (e.g. col 14 ln 62- col 15 ln7); and adapting said processing software executed by said destination computer so that it processes each received data file to carry out said action only when the received data file contains the embedded license stamp, wherein the license stamp embedded in the

data file indicates that the data file was forwarded by licensed server software (e.g. col 15 ln 6-7).

21. Stefik does not use precisely the same terminology as the instant application, e.g., "ticket" in Stefik, rather than "stamp" in the instant application. Mere renaming, however, does not confer patentability.

22. Regarding claims 2-11 –
Stefik discloses the method in accordance with claim 1 wherein said encoded license stamp comprises a code identifying said source computer (e.g. col 13 ln 24-40); wherein said each data file, including its embedded license stamp, is a print file defining a document in a format suitable for directly causing a printer to print said document (e.g. col 4 ln 29-36); wherein said license stamping means embeds said encoded license stamp into the each data file in such a way that said printer ignores the encoded license stamp when printing said document in response to said data file (e.g. col 48 ln 20-26); wherein said action carried out by said processing software comprises displaying on a computer monitor a representation of the document defined by the data file (e.g. col 4 ln 32); wherein said action carried out by said processing software comprises causing said printer to print said document (e.g. col 4 ln 32); wherein said data file defines a sound and wherein said action carried out by said processing software comprises initiating said sound (e.g. col 4 ln 32-33); wherein said data file defines a video image and wherein the action carried out by said processing software comprises initiating a display of said video image (e.g. col 3 ln 50-55); wherein said license stamping means also processes each said data file to determine a value of an attribute of the data file and

includes in said embedded license stamp an attribute code indicating said value of said attribute, and wherein the method further comprises the step of adapting the processing software to process each received data file to determine a value of said attribute of each data file received, and to refrain from processing the received data file to carry out said action unless the received data file includes an embedded license stamp containing said attribute code indicating a value of said attribute patching the value of said attribute determined by said processing software (e.g. table 2); wherein the data file processed by said license stamping means consists of a plurality of data bytes, each of which influences the value of said attribute determined by said license stamping means (e.g. table 2); and wherein said license stamping means includes a processing option code within said license stamp embedded within said data file, and wherein the option code influences the nature of the output the processing software produces when processing the data file (e.g. table 2).

23. As above, Stefik does not use precisely the same terminology as the instant application, e.g., "ticket" in Stefik, rather than "stamp" in the instant application. Mere renaming, however, does not confer patentability.

24. Regarding claim 12-26 –
Claims 12-26 are rejected under the same criteria as above.

25. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and

figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Conclusion

26. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

27. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

28. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina Owen Sherr whose telephone number is 571- 272-6711. The examiner can normally be reached on 8:30-5:00 Monday through Friday.


29. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Fischer can be reached on 571-272-6779. The fax

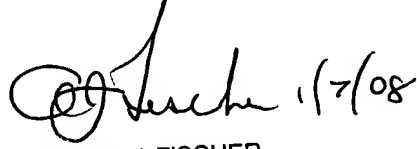
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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

30. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


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